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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,696

06/16/2005

Nicolaas Willem Schellingerhout

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

RAVETTI, DANTE

ART UNIT

PAPER NUMBER

3685

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,696	Applicant(s) SCHELLINGERHOUT ET AL.	
	Examiner DANTE RAVETTI	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/16/2005; 4/30/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This communication is in response to the original Application No. 10/539,696 filed on 16 June 2005.
2. Claims 1-8 are currently pending and have been fully examined.
3. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

Priority

4. The claim for priority from foreign priority application 02080501.6 filed on December 17, 2002 is duly noted.
5. Receipt is acknowledged of papers submitted under 35 U.S.C. §119(a)-(d), which papers have been placed in the file.

Specification

6. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR §1.52(b) (4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.
7. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR §1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR §1.97 and §1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

Claim Rejections – 35 U.S.C. §101

8. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 5-8 are rejected under 35 U.S.C. §101, because the claimed invention is directed to non-statutory subject matter because the claimed subject matter is not within one of the four statutory classes.

As to claim 5-8, they are considered to be Hybrid claims since a person of ordinary skill in the art would recognize that the claim encompasses at least two statutory classes of invention (a claim containing a mixed subject matter) (see MPEP

§2173.05(p) II). Evidence that claim 5 recites a system includes: The preamble ("A system for converting digital rights...."), dependent claim 6 which begins "The system according to claim 5," the transitional phrase "further comprising" and the body of the claim which recites other structural elements, e.g. "device with computing capabilities...." Evidence to support construction that the claim is drawn to a method includes "...is arranged to establish connection with the server for sending the server instructions to convert said limited rights and for accessing the content at the server."

Here the applicant seems to be combining a system claim with a method claim (set of instructions) (e.g. "...sending the server instructions to convert said limited rights..."). Because of the conflicting evidence, the claim is considered a Hybrid claim and the appropriate correction is required.

As to claim 7-8, are also rejected as each recites similar language.

Claim Rejections – 35 U.S.C. §112, 2nd

10. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 2-3, 6-9 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 2 and 6, Applicant states, "...and wherein connection is established with the server, for sending the server instructions to convert said limited rights and accessing the content, from a device with computing capabilities operated by the proprietor of the digital rights. There is no previous mention of connecting with the

server and it is unclear what other device is making the connection. It would be unclear to one of ordinary skill in the art to what is meant by the use of; "...wherein connection is established with the server...." It is also unclear whether this is a step or functional language.¹ The appropriate correction is required.

As to claim 3 and 4, Applicant states, "...and wherein the content is accessed by the device and connection is established with the server for sending the server instructions to convert said limited fights." It would be unclear to one of ordinary skill in the art to what is meant by the use of, "...and wherein content is accessed...." It is also unclear whether this is a step or functional language.² The appropriate correction is required.

As to claims 3 and 7, are also rejected as each recites similar language.

As to claim 8, it is rejected for being dependent upon rejected claim 6.

12. Claims 1-8 are rejected as failing to define the invention in the manner required by 35 U.S.C. §112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a

¹ In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989); An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...

² In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989); An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...

manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim Rejections – 35 U.S.C. §102

13. The following is a quotation of the appropriate paragraphs of **35 U.S.C. §102** that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-8 are rejected under **35 U.S.C. §102(b)** as being anticipated by Ishibashi et al., (US 2008/0154633) ("Ishibashi").

As to claims 1 and 5 :

Ishibashi expressly teaches:

storing digital content and associated limited digital rights [0001], [0009], [0023], [0027], [0035], [0039], [0040], Abstract;

wherein the limited digital rights give a proprietor of the limited rights access to the content a limited number of times [0235], [0238], [0354], [0358], Figure 45(i);

converting, when receiving an instruction in accordance therewith, the limited rights into

an unlimited digital right, wherein said unlimited digital right gives a proprietor of the unlimited right access to the content an unlimited number of times [0235], [0354], [0356], [0358], [0360], [0487], [0492], Figure 45(i), 75, 78;

As to claims 2 and 6:

Ishibashi expressly teaches:

wherein digital content and associated digital rights are stored at a server of a digital content provider and the step of converting said limited rights is performed at said server [0077], [0157], [0162]-[0164], [0220], [0222], [0244], [0423]-[0424],[0480], [0487] Figure. 15 (#51, 64), 67, 74; and

wherein connection is established with the server, for sending the server instructions to convert said limited rights and accessing the content, from a device with computing capabilities operated by the proprietor of the digital rights [0235], [0487].

As to claims 3 and 7:

Ishibashi expressly teaches:

wherein digital content and associated digital rights are stored at a device with computing capabilities, which device is operated by the proprietor of the digital rights, and the step of converting said limited rights is performed at a server of a digital content provider, and wherein the content is accessed by the device and connection is

established with the server for sending the server instructions to convert said limited fights [0243], [0278], [0281], [0485], [0498], [0502], [0509], [0513].

As to claims 4 and 8:

Ishibashi expressly teaches:

wherein digital content and associated digital rights are stored at a device with computing capabilities, which device is operated by the proprietor of the digital rights, and the step of converting said limited rights is performed at said device, and wherein the content is accessed at the device [0243], [0278], [0280], [0281], [0385].

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, please contact the Electronic Business Center (EBC) at 1-(866) 217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1-(800) 786-9199 (IN USA or CANADA) or 1-(571) 272-1000.

/Dante Ravetti/
Examiner, Art Unit 3685
Monday, July 28, 2008

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685